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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,391

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EXAMINER

SAGER, MARK ALAN

ART UNIT

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3714

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,391	<b>Applicant(s)</b> NAKAZAWA ET AL.	
	<b>Examiner</b> M. Sager	<b>Art Unit</b> 3714	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

***Status of Claims***

1. The amendment received 3/6/08 and 11/26/08 amended claims 1, 3-4 and 6-7 and cancels claim 2; thus examination proceeds regarding claims 1 and 3-8.

***Claim Interpretation***

2. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) "adapted to" or "adapted for" clauses, (B) "wherein" clauses, and (C) "whereby" clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat 'l Ass 'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.* In this case, the 'wherein' clauses merely state the environment of use, or intended result or the clause fails to state a condition material to its patentability as provided in further evidence below.

3. Per MPEP 2114, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did

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not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the manner of use fails to critically distinguish over structure taught by references in evidence below.

***Claim Rejections - 35 USC § 102***

4. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Jagged Alliance. Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the disclosure and "equivalents thereof" that correspond to the recited function. Two en banc decisions of the Federal Circuit have made clear that the USPTO is to interpret means plus function language according to 35 U.S.C. § 112, sixth paragraph. *In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848 (Fed. Cir. 1994) (en banc); *In re Alappat*, 33 F.3d 1526, 1540, 31 USPQ2d 1545, 1554 (Fed. Cir. 1994) (en banc). In this case, the Jagged Alliance Manual describes the Jagged Alliance game as having both real time for rapid movement and turn-based movement in virtual space until encounter an enemy when game goes into turn-based play (section 6, Hitting the Beach and section 7, Moving Out; and further evidence under MPEP 2131.01 see Jagged Alliance from wikipedia discusses use of movement points during combat), the Jagged Alliance Manual discloses it is a game device executing game processing stored on memory medium relating to a game character holding attack means, the

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game device having a signal input means as keyboard or mouse as equivalent input device, attack instruction signal input determining means via keyboard or mouse, game character moving means for moving the character in virtual space such as during real time mode via keyboard or mouse entry, attack direction changing means for changing an attack direction resulting from the attack means on the basis of the direction instruction signal inputted by the signal input means such that during combat is turn-based and relies upon direction input from keyboard/mouse, wherein the posture of the game character and attack means is also changed based on the direction instruction such as facing change to face enemy the game character is attacking and wherein the attack means continuously or intermittently attacks an attack target such as via machine gun or pistol for automatic or semi-automatic or single fire. Video footage of Jagged Alliance can be viewed at

[http://www.youtube.com/results?search\\_type=&search\\_query=jagged+alliance&aq=f](http://www.youtube.com/results?search_type=&search_query=jagged+alliance&aq=f)

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. Claim 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jagged Alliance in view of Konami (EP 0840256) or Nakamura (5580308). The Jagged Alliance Manual discloses game features/process but lacks parts data storage means. In related references, Konami (fig 3 and 8-26) and Nakamura (fig 3) each discloses a game having a parts data storage means for storage of parts data representing a posture and relative position from a given origin of each part of the game character wherein said parts data are defined within a game character coordinate system, and linkages related to the body structure of the character with respect to an origin in said character coordinate system are provided, and wherein the attack direction changing means includes parts data partial updating means for updating part of the parts data stored in the parts data storage means on the basis of the direction instruction signal inputted by the signal input means while the attack instruction signal is being inputted by the signal input means, with the attack direction changing means determining the attack direction resulting from the attack means on the basis of the part of the parts data stored by the parts data storage means and wherein the game character moving means includes character origin coordinate storage means for storing position coordinates in the virtual space of the character origin set in the game character, wherein said game character is defined within said virtual space by linkages related to the body structure of the character with respect to said character origin, and wherein the game character moving means updates the position coordinates stored in the character origin coordinate storage means on the basis of the direction instruction signal inputted by the signal input means while the attack instruction signal is being inputted by the signal input means. Konami and Nakamura is each relevant prior art either for being in the field of

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applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Therefore, it would have been obvious to an artisan at a time prior to the invention to apply the process of a parts data storage means for storage of parts data representing a posture and relative position from a given origin of each part of the game character wherein said parts data are defined within a game character coordinate system, and linkages related to the body structure of the character with respect to an origin in said character coordinate system are provided, and wherein the attack direction changing means includes parts data partial updating means for updating part of the parts data stored in the parts data storage means on the basis of the direction instruction signal inputted by the signal input means while the attack instruction signal is being inputted by the signal input means, with the attack direction changing means determining the attack direction resulting from the attack means on the basis of the part of the parts data stored by the parts data storage means and wherein the game character moving means includes character origin coordinate storage means for storing position coordinates in the virtual space of the character origin set in the game character, wherein said game character is defined within said virtual space by linkages related to the body structure of the character with respect to said character origin, and wherein the game character moving means updates the position coordinates stored in the character origin coordinate storage means on the basis of the direction instruction signal inputted by the signal input means while the attack instruction signal is being inputted by the signal input means as taught by Konami and Nakamura to improve the game device, method and computer program product of Jagged Alliance for the

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predictable result of segmenting body part processing for more realistic appearance while reducing processing.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jagged Alliance in view of Rhoades (5181107). Jagged Alliance Manual discloses a game but lacks distribution device claimed since the game is distributed via information storage medium as memory media installed on hard drive or read by device reader as means for reading the program but lacks the means for delivering the program that is over a network. In a related reference, Rhoades discloses system for distributing games to remote subscribers as a means for delivering the program (abstract). Rhoades is relevant prior art either for being in the field of applicant's endeavor or, for being reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The level of ordinary skill is as represented by cited references. Therefore, it would have been obvious to an artisan at a time prior to the invention to apply the process of means for distributing the program as taught by Rhoades to improve the device of Jagged Alliance for the predictable result of allowing remote subscribers to selectively receive game programs to play.

### ***Response to Arguments***

9. Applicant's arguments, see amendment, filed 11/26/08 and as supplemented in amendment, filed 3/6/08, with respect to anticipation by Namco have been fully considered and are persuasive. The rejection of claims 1, and 3-8 has been withdrawn.

10. Applicant's arguments with respect to claims 1 and 3-8 have been considered but are moot in view of the new ground(s) of rejection.



***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Video footage of Jagged Alliance can be viewed at

[http://www.youtube.com/results?search\\_type=&search\\_query=jagged+alliance&aq=f](http://www.youtube.com/results?search_type=&search_query=jagged+alliance&aq=f)

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714